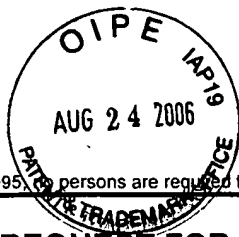


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

5016-2RCE

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on August 22, 2006

Signature

Typed or printed name Edward M. Weisz

Application Number

09/729,984

Filed

12/5/2000

First Named Inventor

Yisroel Lefkowitz

Art Unit

3622

Examiner

R. Alvarez

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 37,257
Registration number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

SignatureEdward M. Weisz

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Telephone number

August 22, 2006

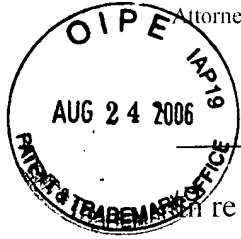
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Yisroel LEFKOWITZ

Serial No.: 09/729,984

Filed: December 5, 2000

For: Method and Apparatus for Selling International
Travel Tickets in Combination with Duty Free
Goods

Examiner: R. Alvarez
Group Art: 3622

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August 22, 2006

(Date of Deposit)

Edward M. Weisz

Name of applicant, assignee or Registered Representative

Signature

August 22, 2006

Date of Signature

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL REQUEST FOR PANEL REVIEW

SIR:

This is a Pre-Appeal Request for Panel Review. The present request is filed concurrently with a Notice of Appeal and is filed before an Appeal Brief. No amendments are being filed with this request.

This Notice of Appeal and Request are filed in response to the final Office Action dated April 25, 2006 in connection with the above-identified application. The pending claims are as set forth in the Amendment dated June 23, 2006. Claims 1, 11, 67 and 76 are in independent form. Claims 1 and 11 recite methods for selling duty free items in combination with international travel tickets obtained from a single source, *i.e.* a single merchant supplies both the international travel ticket(s) and the duty free item(s). Independent claims 67 and 76 recite systems for performing the

methods of claims 1 and 11. The Panel's attention is directed to the description of applicant's invention as set forth on pages 15-16 of applicant's May 2, 2005 Amendment.

In the final Office Action, all pending claims stand rejected (with the exception of claims 6, 16, 28 and 80) as allegedly rendered obvious from U.S. Patent No. 5,732,398 (Tagawa) in combination with a Business Wire article "Air France Corrects And Replaces Previous Announcement" (hereinafter "Business Wire"). Claims 6, 16, 28 and 80 stand rejected as allegedly rendered obvious from Tagawa, Business Wire and a Business Times article. Applicant respectfully submits that these rejections are unfounded.

Tagawa teaches a kiosk which can be used as an interface to connect a consumer with independent, unrelated and separate providers of goods and services. Tagawa provides a communication conduit similar to a telephone or computer terminal having Internet access. If a consumer desires to purchase an airline ticket, the kiosk will connect the consumer to a source for international airline tickets, *e.g.*, an airline ticketing agent or a ticket provider, and the kiosk will issue a receipt for the purchase. Likewise, if the consumer desires to purchase other services, such as a hotel room or rental car, for example, the kiosk will connect the consumer to the source of such services, *i.e.* to other merchants (hotels, rental car companies, etc.) separate and apart from the merchant who provides the international travel ticket. Tagawa does *not* teach that a single merchant would provide both an international travel ticket and duty-free merchandise. Thus, the Tagawa kiosk does not function as a *single source* that provides both international travel tickets and duty free goods, as is required by the pending claims.

In disagreeing with the applicant, the July 24, 2006 Advisory Action refers to col. 18, lines 14-31 of Tagawa as teaching "the kiosk is used as a single source to provide international travel tickets and purchasing duty free merchandise", and refers to col. 18, lines 44-46 of Tagawa as

teaching “the shopping vendors in the region of the regional reservation center may include Duty Free Shoppers . . .”). See p. 2 of the Advisory Action. The cited passages of Tagawa, however, do not support the Examiner’s position. In contrast, these passages are in agreement with applicant’s understanding of Tagawa as explained above, namely, that the Tagawa kiosk merely facilitates one-on-one communication between a consumer and different vendors selling different types of goods or services. In other words, a consumer may use the Tagawa kiosk to purchase an airline ticket from an airline ticketing agent, and then may use the same kiosk to communicate with a rental car service provider or hotel to reserve a car or hotel room. The sale of the airline ticket and the reservation of the rental car are made through the different vendors who provide these goods and services. When a consumer uses the Tagawa kiosk to buy an airline ticket, the kiosk places the consumer in contact with the airline (“contracts are made directly with airlines” -- col. 19, line 16) and an e-ticket, coupon or voucher is issued. When the consumer uses the kiosk to purchase duty-free items, the consumer is put in touch with the duty-free vendor (“The following are some of the possible shopping options: . . . purchasing duty free merchandise. . . . Once the user presses the . . . button on the touch screen 24, the *user will be connected directly to the vendor.*” - col. 18, lines 18-24; emphasis added). There is simply no teaching in Tagawa of a method or system for selling international travel tickets in combination with duty free items from a single source as is required in the independent claims, *i.e.* from a single merchant providing both (1) an international travel ticket and (2) a specific duty free item, as is required by the subject claims.

Tagawa, instead, teaches merely that a single communications terminal may allow a user to contact different merchants. Using the Examiner’s analysis of the Tagawa kiosk, a telephone could be viewed as a “single source” for buying international travel tickets and duty-free merchandise, because both may be purchased over the telephone. But a user who buys these

products must arrange for the purchase of each product separately from the *separate* vendors, with different payment arrangements made to satisfy each vendor. Clearly, however, the airline selling a travel ticket would not have any incentive to provide a free airline ticket to a purchaser of a duty-free wrist-watch simply because the ticket and watch were ordered through the same telephone. Thus, such sales are not made through a “single source”. Tagawa, therefore cannot be read as teaching the use of a single source for the purchase of both international airline tickets and duty-free merchandise as claimed.

As for the Business Wire article, it overcomes none of the deficiencies of Tagawa. The “welcome gift” referred to in the article may be a specific item but is not a “specific duty free item” as is recited in the claims. In fact, in order to receive the “welcome gift” recited in the Business Wire article, a consumer needs to retrieve the gift at one of the department stores mentioned in the article. Because those department stores are not in an international point of debarkation (*e.g.*, airport, *etc.*), the department stores are non-duty free merchants. On the other hand, if the “voucher” referred to in the Business Wire article is used, that voucher is not for a “specific duty free item” as required in the claims. Rather, that voucher is “good in duty free shops at Paris/Charles de Gaulle Airport”. In other words, a consumer obtaining the voucher can use the voucher to purchase any type of duty free goods in a duty free shop at the airport. The Business Wire article makes no mention that the voucher is for a “specific duty free item” and, in any event, the specific item is *not* available from the same source as the international travel ticket.

For all of the foregoing reasons, the combination of Tagawa with the Business Wire reference does not render applicant’s claims obvious. Furthermore, the combination of those references teach away from applicant’s invention because Tagawa does not disclose a *single source* providing international travel tickets and duty free goods, and the Business Wire article does not

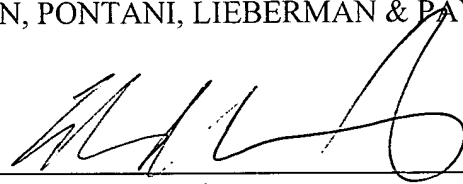
disclose providing a specific duty free item. Such a combination, therefore, even if it was permissible, does not result in the invention as claimed. Moreover, the non-obviousness of applicant's invention as set forth in the claims is further supported by the Declarations Under 37 C.F.R. §1.132 submitted on February 13, 2006 by the applicant during prosecution.

Because the independent claims are believed to be allowable for the reasons set forth above, it is also believed that the dependent claims are allowable as well.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE LLP

By



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Dated: August 22, 2006